

REMARKS

Claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89 and 92 are pending in the present application. Applicant has canceled claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89 and 92. Applicant is submitting additional claims 95-142. Applicant respectfully requests consideration and examination of claims 95-142.

The following remarks are in response to the Office Action dated April 16, 1997 (paper no. 10) in the parent application Serial No. 08/416,037.

1. Response To Objections/Rejections Not Based On Prior Art

The Examiner has objected generally to the disclosure, stating:

This disclosure --including disclosed specification, drawings, and claims-- is replete with grammatical, style, punctuation, and typographical errors too numerous to mention all specifically.

Applicant must correct all errors in the application, whether or not specifically mentioned in this office action.

Applicant has amended the specification, canceled all pending claims and provided new claims 95-142. Applicant submits that the amendments do not introduce new matter.

The Examiner has approved Figs. 4A-4E and 5A-5E as informal figures acceptable for examination purposes. Applicant will submit formal drawings when the application is allowed.

The Examiner has objected to the specification under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention. The Examiner states:

Because of the state of the detailed specification, it does not enable one of reasonable skill to make and practice the invention of claims 23-94. Due the generally improper and idiomatic English used in this application, it is unclear wherein the detailed specification does the Applicant discuss the invention of the claims so as to enable one of reasonable skill in the art to make and use it. Moreover, in very many places it is unclear whether Applicant discusses an invention presented in a prior Japanese application or describes the invention of this application.

Applicant respectfully disagrees. Applicant submits that the specification as amended adequately teaches how to make and/or use the invention. With respect to the prior Japanese applications, Applicant submits that it is not unclear in the specification as amended as to whether Applicant discusses the invention of this application or an invention presented in a prior Japanese application.

The Examiner has objected to the ordering of the claims. Applicant has provided new claims 95-142 in accordance with 37 C.F.R. § 1.75(g).

The Examiner has rejected claims 23-94 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. The Examiner states:

As an example of the numerous mistakes, which render uncertain scope of the claims, Examiner notes that in claim 23, the recitation "copying said digital data a transfer utilization permit key ..." is incomprehensible (could Applicant be meaning to recite "copying said digital data and a transfer utilization permit key..."?); as well as "storing said digital data is said utilization permit key ..." (Could Applicant be meaning to recite "storing said digital data [is] ifsaid utilization permit key ..."?).

Applicant has canceled the prior claims 23-94 and submitted new claims 95-142 for the Examiner's consideration.

2. Response To Rejections Based On Prior Art

The Examiner has rejected claims 23-94 under 35 U.S.C. § 102 (e) as being anticipated by any of Dolphin, Fahn et al., Okano, Matsumoto et al., or Gasser et al. The Examiner states:

The cited prior art, either expressly or inherently, teaches all of the limitations of the claims. Examiner notes that the claims recite, the possible alternative use of a display permit key, an edit permit key, a storage permit key, a copy permit key, and a transfer utilization permit key. Consequently, all that the prior art has to have is one of said permit keys and the corresponding steps. The cited prior art, each, teaches a crypt key as well as at least one permit key and the corresponding steps that is the same or equivalent to the recited limitations in this application. Examiner notes that the cited prior art deals with data protected by encryption, which expressly and inherently requires a crypt key.

Applicant respectfully disagrees. Applicant has canceled prior claims 23-94, and submitted new claims 95-142, including independent claims 95, 111

and 127. In independent claims 95, 111 and 127, using a copyright control program is included, and the functions of the copyright control program and each utilization permit key are clearly defined.

According to the invention described in claims 95, 111 and 127, primary illegitimate utilization of the digital data can be prevented, and secondary utilization, namely editing, storing, copying or transferring of the digital data, can be performed in the case of an authorized utilization.

According to the invention described in claims 111 and 127, in the case where the digital data is stored, copied or transferred, the digital data is encrypted again. Thus, illegitimate primary and secondary utilization can be prevented.

Further, according to the invention described in claims 95, 111 and 127, the utilization permit key including a crypt key is supplied from the key control center, and decrypting, encrypting again and each utilization of the digital data are managed by the copyright control program. The copyrights of the digital data are therefore reliably secured against illegitimate utilization by a user.

In contrast, in the cited references:

Dolphin prevents unauthorized primary utilization of digital data which is distributed from CD-ROM and the like, and does not refer to secondary utilization of digital data, i.e., editing, storing, copying or

transferring of the digital data. Dolphin does not teach or suggest a copyright control program, respective utilization permit keys for editing, storing, copying and transferring as secondary utilization of the digital data, and encrypting again, which are the means for preventing illegitimate utilization. Also, Dolphin does not show that decrypting and encrypting again, and control of display, edit, store, copy and transfer operations are managed by the copyright control program.

Fahn prevents unauthorized primary utilization of digital data which is distributed via broadcast, and does not refer to secondary utilization of digital data, i.e., editing, storing, copying or transferring of the digital data. Fahn does not teach or suggest a copyright control program, respective utilization permit keys for editing, storing, copying and transferring as secondary utilization of the digital data, and encrypting again, which are the means for preventing illegitimate utilization. Also, Fahn does not show that decrypting and encrypting again, and control of display, edit, store, copy and transfer operations are managed by the copyright control program.

Although Okano re-encrypts the digital data for security, the re-encryption is not for protecting copyrights of the digital data. In Okano, encrypting/decrypting are managed by a user. Okano does not refer to editing, storing, copying or transferring the digital data. Also, Okano does not show that decrypting and encrypting again, and control of display, edit, store, copy and transfer operations are managed by the copyright control program.

Matsumoto relates to digital signatures used for verification of e-mail or the like. Encryption is performed using a private key of secret digital data. Matsumoto does not show the prevention of illegitimate primary utilization of the digital data and secondary utilization of the digital data, i.e., editing, storing, copying or transferring. Matsumoto does not teach or suggest a copyright control program, respective utilization permit keys for editing, storing, copying and transferring as secondary utilization of the digital data, and encrypting again, which are the means for preventing illegitimate utilization. Also, Matsumoto does not show that decrypting and encrypting again, and control of display, edit, store, copy and transfer operations are managed by the copyright control program.

Gasser relates to data security in a computer system and does not refer to secondary utilization of the digital data, i.e., editing, storing, copying or transferring. Gasser, therefore, does not teach or suggest a copyright control program, respective utilization permit keys for editing, storing, copying and transferring as secondary utilization of the digital data, and encrypting again, which are the means for preventing illegitimate utilization. Also, Gasser does not show that decrypting and encrypting again, and control of display, edit, store, copy and transfer operations are managed by the copyright control program.

As described above, independent claims 95, 111 and 127, and dependent claims 96-110, 112-126 and 128-142, are not anticipated by Dolphin, Fahn,

Okano, Matsumoto, or Gasser. Applicant therefore submits that claims 95-142 are in condition for allowance.

The Examiner has rejected claims 24-58 and 60-94 under 35 U.S.C. § 103 as being unpatentable over any of Dolphin, Fahn, Okano, Matsumoto, or Gasser as applied to claims 23 and 59, and further in view of what is well known. The Examiner states:

The deficiencies of the cited prior art, if any, with respect to the dependent claims 24-58 and 60-94 deal with features that are well known and commonly used in the art. Such features would, therefore, have been obvious to incorporate in the cited prior art.

For example, it is well known to attach a digital signature to transmitted data to allow receivers to authenticate origin of received data and verify the absence of unauthorized changes in the data. It is also well known in the art to use copyright control messages and information along with copyrighted data to provide information about the use and control of the copyrights. It is also known in the art to use encrypted permit keys to prohibit the unauthorized access of protected data.

Applicant respectfully disagrees. Applicant submits that all claims dependent upon allowable base claims are themselves allowable over the cited art. As described above with respect to claims 95, 111 and 127, none of the cited references describes controlling copyrights of digital data as claimed.

Further, Applicant submits that it is not well known to use digital signatures for controlling database copyrights, nor is it well known to use copyright control messages and information for controlling database copyrights as is claimed in the present application. Similarly, it is not known

in the art to use encrypted permit keys as claimed to prohibit the unauthorized access of protected data. The cited references fail to teach or suggest any such combination.

3. Rejections Based On Double Patenting

The Examiner states that the commonly assigned U.S. Patent Application No. 08/549,271 would form the basis for a rejection of the claims 23-94 under 35 U.S.C. § 103 (a) if the commonly assigned case qualifies as prior art under 35 U.S.C. § 102 (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made.

The Examiner further states that, in order to resolve this issue, the assignee is required under 37 C.F.R. § 1.78 (c) and 35 U.S.C. § 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter.

Accordingly, Applicant hereby names the inventor of U. S. Application No. 08/549,271 as the same inventor of the current application, Makoto Saito. Applicant submits that, because the inventorship is the same, U. S. Application No. 08/549,271 does not qualify as prior art under 35 U.S.C. § 102 (f) or (g).

The Examiner has provisionally rejected claims 23-94 under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1-26 of copending Application Serial No. 08/549,271.

The Examiner states:

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of said U.S. Application anticipate the claims in this application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US SN 08/549,271 teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, US SN 08/549,271 anticipates the edit permit key and its corresponding steps, as one of the alternate limitations recited in claims 23-94.

Applicant respectfully disagrees. Claims 1-26 of US SN 08/549,271 do not anticipate new claims 95-142 of the present application. For example, the claims of US SN 08/549,271 do not anticipate a display permit key, an edit permit key, a storage permit key, a copy permit key and a transfer permit key, as recited in independent claims 95 and 127. Nor do the claims of US SN 08/549,271 anticipate decrypting, displaying, editing, storing, copying and transferring data under management of a copyright control program. Applicant therefore submits that claims 95-142 are patentably distinct from the subject matter claimed in US SN 08/549,271.

The invention of new claims 95-142 of the present application is distinct from claims 1-26 of U.S. Patent Application Serial No. 08/549,271 and not anticipated therefrom. In claim 1 of US SN 08/549,271, new data is produced from a plurality of original data, as described "said primary user produces new data which is produced from a plurality of edited data by editing said plurality of original data using an edit program." In contrast, in

claims 95-142 of the present application, "a digital data" is displayed, edited, stored, copied or transferred.

The Examiner has provisionally rejected claims 24-58 and 60-94 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application Serial No. 08/549,271 and further in view of what is well known. Applicant respectfully disagrees. As stated above, independent claims 95, 111 and 127 are patentably distinct from the subject matter claimed in US SN 08/549,271. Dependent claims 96-110, 112-126 and 128-142, including all limitations of respective base claims 95, 111 and 127, are also patentably distinct.

As described, the subject matter claimed in US SN 08/549,271 and in the present application are distinct from each other, and therefore, the subject matter claimed in the present application is not inherent in that claimed in US SN 08/549,271, and the subject matter claimed in US SN 08/549,271 is not inherent in that claimed in the present application.

Consequently, *In re Thorington*, 418 F.2d 528, 163USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993), which are all based on subject matters being not distinct, should not be referenced on double patenting in this case.

CONCLUSION

Applicant submits, for the foregoing reasons, that newly submitted claims 95-142 are allowable over the cited art and patentably distinct from U.S. Application Serial No. 08/549,271. Therefore, Applicant submits that the present application is in condition for allowance. Applicant respectfully requests that a Notice of Allowance be issued.

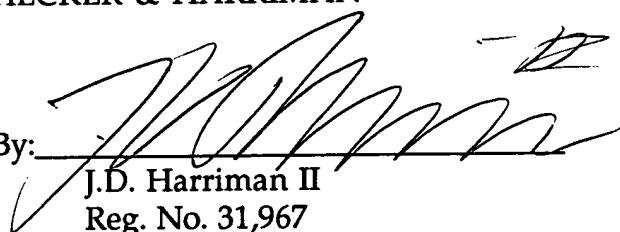
Respectfully submitted,

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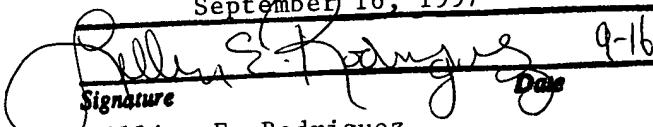
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